



ATTACHMENT A

Remarks

Considering the matters raised in the Office Action in the same order as raised, claims 1-3, 6, 8-16, 18, 22, 23 and 32-34 have been rejected under 35 USC 103(a) as being unpatentable over Thomas in view of Irvin. In addition, claim 35 has been rejected under 35 USC 103(a) as being "unpatentable over Thomas in view of Fostick as applied to claim(s) 1 above, and further in view of Irvin." With respect to the rejection of claim 35, because Fostick is no longer applied to claim 1, it is assumed that this rejection is based on the combination of Thomas and Irvin. These rejections are respectfully traversed although claims 1 and 18 have been amended to more clearly distinguish over the cited references as discussed below.

Turning now to the individual claims, in the rejection of claim 1, the Examiner admits that "Thomas fails to disclose identification codes for each of said compatible devices being preprogrammed into the cellular telephone." However, the Examiner argues that "Irvin teaches identification codes for each of said compatible devices being pre-programmed into the cellular telephone so as to enable a name of a person to be associated with each said compatible device (FIG. 4 and column 6, lines 48-64)." The Examiner argues that "[t]herefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Thomas using the teaching of multiple entry phonebooks as taught by Irvin." The Examiner supports this argument by concluding that this "modification of the invention enables the system to disclose identification codes for said compatible devices being preprogrammed into the cellular telephone so that the user would organize the names and number of the conference participants."

The Irvin patent discloses a wireless communications terminal including a first transducer that communicates with a first wireless communications system such as a cellular communications system and a second transducer that communicates with a second wireless communications system such as a bluetooth or FRS system. A multiple entry phonebook includes a first wireless communication system access number and a second wireless communication access number for each of one or more entities. The multiple-entry phonebook is indicated at 400 in Figure 4 referred to by the

Examiner, and the passages at column 6, lines 48-65, also referred to by the Examiner, provide that identification 405 may comprise an entity number, names or other identification.

It is respectfully submitted that the mere fact that multiple entry phonebooks exist, as evidenced by the Irvin reference, does not mean that it would be obvious to incorporate such a phonebook into the Thomas system. Thomas is concerned with a method and apparatus for setting up a conference call in which one of a group of communication devices connected to a low power radio frequency (LPFR) network is able to set up a call to a party external of the network, and involves the use of both a PLLN 4 and the LPFR network. In contrast, Irvin is simply concerned with a phonebook for first and second different types of wireless systems for assisting a user in placing a call using either system. Thus, it is respectfully submitted that the stated motivation ("so that the user would organize the names and numbers of the conference participants") is not based on the teachings of either reference, and that the proposed combination is necessarily the improper product of hindsight.

In addition, claim 1 has been amended to include the subject matter of claim 35 which has now been canceled. Thus, claim 1 now additionally recites a microphone coupled to the claimed combining means and a speaker coupled to the combining means such that the sound generated at the microphone is not played at the speaker. It is respectfully submitted that the Irvin patent does not disclose this feature.

Considering the latter contention in more detail, in rejecting claim 25 (which includes a similar recitation), the Examiner has made reference to "combining means" 282, to element 274 of Figure 2 and to column 5, lines 55-56 and column 6, lines 26-34, while in rejecting claim 35 (now incorporated into claim 1), the Examiner has made reference to Figure 2 and lines 34-50 of column 5 of Irvin. However, it is respectfully submitted that Figure 2 and the cited lines merely disclose the use of a microphone and a speaker, and do not disclose a microphone and a speaker coupled to combining means such that the sound generated at the microphone is not played at the speaker. In this respect, lines 34-50 of column 5 to which the Examiner has referred merely make reference to "speaker 274 and/or microphone 282" and contain no teachings or suggestion that these elements operate as claimed. In fact, the use of "and/or" in

reference to the speaker and microphone indicates that the two need not be used together. Moreover, it is not seen how lines 55-66 of column 5 and lines 26-34 of column 6, which concern ganged switches 324 and 334, are relevant. In any event, it is respectfully submitted that claim 1 is additionally patentable in light of the limitations imported therein from claim 35. Thus, even assuming for the sake of argument that it would be obvious to combine the Thomas and Irvin references, the resultant hybrid combination would not be that now claimed in amended claim 1.

Turning to independent claim 11, this claims recites, inter alia, using a second transceiver to broadcast a request for compatible third party devices within a desired local area to identify themselves, generating a list of the devices responding to the request, and selecting at least one third party device from the list.

In rejecting claim 11, the Examiner admits that Thomas "fails to disclose generating a list of third party devices responding to the request and selecting of at least one third party device from the list." However, the Examiner contends that "Irvin teaches generating a list of the third party devices responding to the request (FIG. 4 and column 6, lines 48-65); and selecting of at least one third party device from the list (FIG. 4 and column 6, lines 48-65)." The Examiner concludes that "it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Thomas using the teaching of multiple entry phonebooks as taught by Irvin" and contends that this "modification of the invention enables the system to disclose identification codes for said compatible devices being preprogrammed into the cellular telephone so that the user would organize the names and numbers of the conference participants."

It is respectfully submitted that the lines in question of column 6 and the showing in Figure 4 are simply not a teaching of using a second transceiver to broadcast a request for compatible third party devices within a local area network to identify themselves and then generating a list of devices responding to the request. The teachings of the Irvin patent with respect to a multiple entry phonebook have been discussed above. The disclosure in Irvin of a multiple entry phonebook is clearly not a teaching of the subject matter of claim 11. Hence, claim 11 patentably defines over the combination of Thomas and Irvin for at least this reason. Moreover, it is respectfully

submitted that the supporting arguments made in the Office Action and quoted above relate to claims 25 and 35 and not to claim 11.

Independent claim 18 has been amended to include a limitation similar to that discussed above in connection with claim 11 and, in this regard, provides that the method further comprises "identifying compatible third party devices by broadcasting a request for compatible third party devices in the range of the local area receiver to identify themselves and adding to the menu third party devices responding to the request." Again, this feature patentable defines over the proposed combination even assuming for the sake of argument that that combination is a proper one.

Finally, with respect to independent claim 25, this claim distinguishes over the prior art for the reasons discussed above in connection with the new recitation added to claim 1. It is noted that although the shortcomings of the Irving patent as a reference against claim 25 have been discussed in previous responses, the Examiner has not addressed this discussion. Thus, if the Examiner intends to pursue this rejection, it is respectfully requested that the Examiner specifically point out why the feature in question is deemed to be disclosed by Irvin.

Allowance of the application in its present form is respectfully solicited.

END REMARKS